

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of : Davies, Matthew A. et al.
Application No. : 10/806,603
Filed : March 23, 2004
For : Methods For Creating Assemblies and Disassembling
Examiner : Hong, John C.
Art Unit : 3726

Mail Stop: Issue Fee
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Petition Regarding Patent Term Adjustment (PTA)

Indicated in Notice of Allowance

Sir:

1. A Notice of Allowance was mailed on December 1, 2009 for the present application. One of the attachments to the Notice of Allowance was a Determination of Patent Term Adjustment Under 35 USC § 154(b) that indicated that the total patent term adjustment (PTA) to date is 0 days. It is believed that the correct total PTA to date is 150 days.

2. The determination of the total PTA of 0 days is erroneous because the US Patent & Trademark Office's (PTO) PTA calculator failed to account for two separate PTO delays. The two PTO delay periods should have their days added together in accordance with the reasoning in *Wyeth et al. v. Dudas*, No. 07-1492 (D.D.C. September 30, 2008), *aff'd Wyeth et al. v. Dudas*, No. 2009-1120 (Fed. Cir. Jan. 7, 2010). The PTA calculation only accounts for one of the delays of the PTO. As a result of accounting for both delays of the PTO, both delays warrant a PTA credit of 431 days for PTO delay under 35 USC § 154(b)(1)(A) and 37 CFR § 1.702(a)(1) and 35 USC § 154(b)(1)(B) and 37 CFR § 1.702(b). The two periods of delay do not overlap, Applicants are entitled to the sum of these two periods. Accordingly, a total PTA credit of 431 days (i.e., 134 days

+ 297 days) is appropriate based upon the PTO delay. The total number of PTA debits of 281 days for applicant delay that is shown on the PTA History on the PTO website is correct. Thus, the correct total PTA to date is 150 days (i.e., 431 days – 281 days).

3. Thus, Applicants believe that the total PTA credit for PTO delay is 431 days, the total PTA debit for applicant delay is 281 days, and the total PTA under 37 CFR § 1.703(f) is 150 days.

4. In accordance with 37 CFR § 1.705(b), this application for patent term adjustment is filed no later than the payment of the issue fee but after the date of mailing of the notice of allowance.

5. The following statements are required by 37 CFR § 1.705(b)(2)(i).

- i) The correct total PTA credit is 431 days.
- ii) The basis for the 128 days of PTA credit is under § 1.702(a)(1) and is due to the PTO's failure to mail a notification under 35 USC § 132 or a notice of allowance within 14 months of the application's filing date. The basis for the 297 days of PTA credit is under § 1.702(b) and is due to the PTO's failure to issue a patent within three years of the filing date. The basis for the 6 days of PTA credit is under § 1.703(a)(2) and is due to PTO's failure to reply after the date that is four months after the date a reply was filed.
- iii) The basis for the 281 days of PTA debit under § 1.704(b) is due to the Applicant's failure to reply to actions by the PTO within three months after the date on which the action was mailed.
- iv) The total PTA under § 1.703(f) is projected to be 150 days, which is the total PTA credit for PTO delay of 431 days less the PTA debit for applicant delay of 281 days.

6. The following statements are required by 37 CFR § 1.705(b)(2)(ii).
- i) The relevant dates as specified in 37 CFR § 1.703(a)(1) for one part of the PTA credit are as follows: the date of May 23, 2005 which is the date that is fourteen months after the date on which the application was filed under 35 USC § 111(a); and the date of September 28, 2005, which is the mailing date of a notification under 35 USC § 132. Thus, the period of delay runs from May 23, 2005 to September 28, 2005. This period of delay is 128 days.
 - ii) The relevant dates as specified in 37 CFR § 1.703(b) for the other part of the PTA credit are as follows: the date of March 24, 2007 which is the day after the date that is three years after the date on which the application was filed under 35 U.S.C. 111(a); and the date on which a Request for Continued Examination was filed on January 14, 2008. Thus, the period of delay runs from March 24, 2007 to January 14, 2008. This period of delay is 297 days.
 - iii) The relevant dates as specified in 37 CFR § 1.703(a)(2) for PTO's failure to reply after the date that is four months after the date a reply was filed are as follows: the date of December 22, 2008 which is the date on which a Response to a Non-Final Office Action was filed; and the date on which the PTO mailed a Final Office Action on April 28, 2009. This period of delay is 6 days.

8. Any patent granted on this application is not subject to a terminal disclaimer. See 37 CFR § 1.705(b)(2)(iii)

9. The following statements are required by 37 CFR § 1.705(b)(2)(iv)(A) and list circumstances during the prosecution of this application constituting a failure to engage in reasonable efforts to conclude processing or examination of the above-identified patent application as set forth in 37 CFR § 1.704.

- i) The After-Final Response to an Office Action was filed January 12, 2007 after the three month period for filing a response. Under 37 CFR § 1.704(b), the period of adjustment for delay associated with this reply begins on the day after the date that is three months after the date of mailing of the Final Office Action on September 7, 2006 and ends on the date the reply was filed. Thus the period of delay runs from December 8, 2006 to January 12, 2007. This period of delay is 36 days.
- ii) The Response to Non-Final Rejection filed June 7, 2007 under 37 CFR § 1.111 was filed after the three month period for filing a response. Under 37 CFR § 1.704(b), the period of adjustment for delay associated with this reply begins on the day after the date that is three months after the date of mailing of the Non-Final Rejection on February 7, 2007 and ends on the date the reply was filed. Thus the period of delay runs from May 8, 2007 to June 7, 2007. This period of delay is 31 days.
- iii) The Request for Continued Examination in response to Final Rejection filed January 14, 2008 was filed after the three month period for filing a response. Under 37 CFR § 1.704(b), the period of adjustment for delay associated with this reply begins on the day after the date that is three months after the date of mailing of the Final Rejection on September 13, 2007 and ends on the date the reply was filed. Thus the period of delay runs from December 14, 2007 to January 14, 2008. This period of delay is 32 days.
- iv) The Response to Non-Final Rejection filed July 28, 2008 under 37 CFR § 1.111 was filed after the three month period for filing a response. Under 37 CFR § 1.704(b), the period of adjustment for delay associated with this reply begins on the day after the date that is three months after the date of mailing of the Non-Final

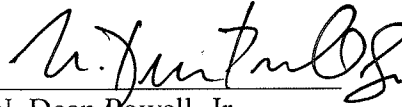
Rejection on January 29, 2008 and ends on the date the reply was filed. Thus the period of delay runs from April 30, 2008 to August July 28, 2008. This period of delay is 90 days.

- v) The Request for Continued Examination in response to Final Rejection filed October 28, 2009 was filed after the three month period for filing a response. Under 37 CFR § 1.704(b), the period of adjustment for delay associated with this reply begins on the day after the date that is three months after the date of mailing of the Final Rejection on April 28, 2009 and ends on the date the reply was filed. Thus the period of delay runs from April 29, 2009 to October 28, 2009. This period of delay is 92 days.
- vi) The total PTA debit for applicant delay is 281 days (36 days + 31 days + 32 days + 90 days + 92 days).

10. Applicant reserves the right to file a supplemental Request for Correction of PTA under 37 CFR § 1.705(d) in the event the patent issues on a date other than June 29, 2010.

Respectfully submitted,

Date: 02/26/10


N. Dean Powell, Jr.
Reg. No. 58,909

Encl. - Exhibit A - Copy of PTA History for Application No. 10/806,603 Printed from PAIR February 26, 2010

10/806,603	METHODS FOR CREATING ASSEMBLIES AND DISASSEMBLING	02-26-2010::11:14:48
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Patent Term Adjustments

Patent Term Adjustment (PTA) for Application Number: 10/806,603

Filing or 371(c) Date:	03-23-2004	USPTO Delay (PTO) Delay (days):	-
Issue Date of Patent:	-	Three Years:	-
Pre-Issue Petitions (days):	-	Applicant Delay (APPL) Delay (days):	-
Post-Issue Petitions (days):	-	Total PTA (days):	0
USPTO Adjustment(days):	-	Explanation Of Calculations	

Patent Term Adjustment History

Date	Contents Description	PTO(Days)	APPL(Days)
12-01-2009	Mail Notice of Allowance		
11-30-2009	Document Verification		
11-30-2009	Notice of Allowance Data Verification Completed		
11-30-2009	Examiner's Amendment Communication		
11-25-2009	Examiner Interview Summary Record (PTOL - 413)		
10-31-2009	Date Forwarded to Examiner		
10-31-2009	Date Forwarded to Examiner		
10-28-2009	Request for Continued Examination (RCE)		92
10-31-2009	Disposal for a RCE / CPA / R129		⬆
10-28-2009	Request for Extension of Time - Granted		⬆
10-28-2009	Workflow - Request for RCE - Begin		⬆
04-28-2009	Mail Final Rejection (PTOL - 326)	6	
04-27-2009	Final Rejection	⬆	
02-12-2009	Date Forwarded to Examiner	⬆	
12-22-2008	Response to Election / Restriction Filed	⬆	
11-21-2008	Mail Restriction Requirement		
11-20-2008	Requirement for Restriction / Election		
09-22-2008	Date Forwarded to Examiner		
07-28-2008	Response after Non-Final Action		90
07-28-2008	Request for Extension of Time - Granted		⬆
01-29-2008	Mail Non-Final Rejection		⬆
01-22-2008	Non-Final Rejection		
01-15-2008	Date Forwarded to Examiner		
01-15-2008	Date Forwarded to Examiner		
01-14-2008	Request for Continued Examination (RCE)		32
01-15-2008	Disposal for a RCE / CPA / R129		⬆
01-14-2008	Request for Extension of Time - Granted		⬆
01-14-2008	Workflow - Request for RCE - Begin		⬆
12-21-2007	Mail Advisory Action (PTOL - 303)		⬆
12-20-2007	Advisory Action (PTOL-303)		⬆
12-19-2007	Date Forwarded to Examiner		⬆

Exhibit A

12-13-2007	Amendment after Final Rejection	⌆
09-13-2007	Mail Final Rejection (PTOL - 326)	⌆
09-04-2007	Final Rejection	
06-18-2007	Date Forwarded to Examiner	
06-07-2007	Response after Non-Final Action	31
06-07-2007	Request for Extension of Time - Granted	⌆
06-08-2007	Mail Examiner Interview Summary (PTOL - 413)	⌆
03-08-2007	Examiner Interview Summary Record (PTOL - 413)	⌆
02-07-2007	Mail Non-Final Rejection	⌆
02-05-2007	Non-Final Rejection	
01-24-2007	Date Forwarded to Examiner	
01-12-2007	Amendment after Final Rejection	36
01-12-2007	Request for Extension of Time - Granted	⌆
01-04-2007	Mail Advisory Action (PTOL - 303)	⌆
12-28-2006	Advisory Action (PTOL-303)	⌆
12-21-2006	Date Forwarded to Examiner	⌆
12-07-2006	Amendment after Final Rejection	⌆
09-07-2006	Mail Final Rejection (PTOL - 326)	⌆
09-05-2006	Final Rejection	
06-23-2006	Date Forwarded to Examiner	
06-19-2006	Response to Election / Restriction Filed	
05-17-2006	Mail Restriction Requirement	
05-15-2006	Requirement for Restriction / Election	
03-02-2006	Date Forwarded to Examiner	
02-16-2006	Response after Non-Final Action	
11-16-2005	Mail Non-Final Rejection	
11-14-2005	Non-Final Rejection	
03-23-2004	Information Disclosure Statement considered	
11-04-2005	Date Forwarded to Examiner	
10-28-2005	Response to Election / Restriction Filed	
09-28-2005	Mail Restriction Requirement	128
09-26-2005	Requirement for Restriction / Election	⌆
11-15-2004	IFW TSS Processing by Tech Center Complete	⌆
03-23-2004	Reference capture on IDS	⌆
03-23-2004	Information Disclosure Statement (IDS) Filed	⌆
03-23-2004	Information Disclosure Statement (IDS) Filed	⌆
11-15-2004	Case Docketed to Examiner in GAU	⌆
06-07-2004	Application Return from OIPE	⌆
06-07-2004	Application Return TO OIPE	⌆
06-05-2004	Application Dispatched from OIPE	⌆
06-07-2004	Application Is Now Complete	⌆

04-19-2004	Cleared by OIPE CSR	⬆
03-31-2004	IFW Scan & PACR Auto Security Review	⬆
03-23-2004	Initial Exam Team nn	⬆

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